

***Advisory Action
Before the Filing of an Appeal Brief***

Application No.

10/579,843

Applicant(s)

GOLDACKER ET AL.

Examiner

Nathan M. Nutter

Art Unit

1796

–THE MAILING DATE of this communication appears on the cover sheet with the correspondence address –

THE REPLY FILED 18 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: 5
 Claim(s) rejected: 1-4 and 6-14
 Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: With regard to the rejection of claims 1-4 and 6-14 under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Yang et al (US 6,841,612), applicants argue the claim language require the matting agent to be 100% by weight in the entirety of constituents. The claim language does not exclude additional constituents, that may be characterized as other than a matting agent or even in addition to, even in major amounts. While the "entirety of the constituents b1), b2), and, where appropriate b3) and/or b4) gives 100% by weight (of the claimed matting agent, per se)," other constituents may be included. The same is true for the filler. The claims do not exclude the presence of filler materials. The claims are specific as to the weight % of the constituents of the matting agent, per se, but do not exclude other constituents. The phrase the "entirety of the constituents b1) and b2), etc." does not find support in the Specification as to provide a definite and exclusive/inclusive relationship, nor is it recited in the claims. What may be defined as the matting agent, per se, is recited in the claims. However, the claim language is viewed in the breadth as written and not subject to a limited interpretation. As regards the filler component of the reference, a skilled artisan would be aware of the relationships of the properties of a composition and fillers, just as applicant states, and would know how to manipulate the inclusion or exclusion thereof to achieve desired benefits. As regards the crosslinking agent, the reference clearly shows applicants upper limit and teaches what is to be obtained by using less. Applicants have shown nothing unexpected.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 07-08-09 and 09-03-09
 13. ☒ Other: See Continuation Sheet.

/Nathan M. Nutter/
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U.S. Patent and Trademark Office
PTOL-303 (Rev. 08-06)

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Part of Paper No. 20090929

Continuation of 5. Applicant's reply has overcome the following rejection(s): The provisional rejection of claims 1,2, 5, 10, 11, 13 and 14 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-41 and 43-46 of copending Application No. 10/575,929 (US 2007/0055017) Schultes et al.

Continuation of 13. Other: Claim 5 would be objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims..